

Docket No.: 29827/38367A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Norbert Herfert et al.

Application No.: 10/511,193

Confirmation No.: 8679

Filed: October 12, 2004

Art Unit: 1772

For: PLASTICIZED SUPERABSORBENT
POLYMER SHEETS AND USE THEREOF IN
HYGIENIC ARTICLES

Examiner: C. A. Simone

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Office Action dated June 29, 2007, applicants are required to elect one of the following groups of claims:

Group (I), claims 1-17, inclusive, directed to a flexible absorbent sheet; or

Group (II), claims 18-27, inclusive, directed to an absorbent article (a diaper).

Applicants hereby elect the claims of examiner's Group I, namely, claims 1 through 17, inclusive, with traverse, for examination on the merits at this time. Claims encompassing the elected invention are claims 1-17.

It is submitted, however, that all claims 1 through 27 should be examined at this time. According to PCT Rule 13, claims of different categories with common special technical features do *not* lack unity. Also, see Example 1 in PCT Gazette, page 52, Part 2 I. (copy enclosed).

In the present invention, the common special technical feature in *all* claims is a flexible absorbent sheet comprising (a) a superabsorbent polymer component comprising at least one of each of an unneutralized acidic resin and an unneutralized basic resin, and (b) a plasticizer, wherein the sheet contains about 60% to 100% of components (a) and (b), as recited in claim 1, for example. There may be a lack of unity only if this common technical feature lacks novelty or is obvious. See PCT Gazette page 49, part 1(a) (copy enclosed).

Unity of invention in the present application is evidenced further by the International Search Report. In particular, *all* claims were searched. The standards regarding unity of invention that apply to the International Searching Authority *also* apply to the U.S. Patent Office with respect to this application. Therefore, the unity of invention requirement is fulfilled, and any reliance upon independence or distinctness of the invention is not relevant under the PCT.

In addition, M.P.E.P. §1893.03(d) provides that when making a lack of unity of invention requirement, the examiner *must* "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." A group of inventions is considered linked as to form a single general inventive concept when a technical relationship exists among the inventions that involves at least one common or corresponding special technical feature. That common special technical feature is present in *all* of claims 1-27.

The examiner relies upon U.S. Patent No. 5,962,578 to support a contention of lack of unity, stating that the '578 patent discloses the feature of claim 1. Applicants disagree. The '578 patent is totally silent with respect to: (a) a flexible sheet, (b) a plasticizer and (c) a sheet containing 60% to 100% of the plasticizer and superabsorbent polymer component. Accordingly, the special technical feature of the claimed invention *does* define a contribution over the prior art.

The examiner has not provided *proper* reasons why each group lacks unity with each other group, specifically describing the unique special technical feature in each group as required in M.P.E.P. §1893.03(d). The examiner has considered the type of claims, e.g., flexible sheet and absorbent articles (diaper), without considering the special technical

features recited in, and common to, each claim, as set forth above. Furthermore, it must be noted that the claims of examiner's Groups II, claims 18-27, *depend* from claim 1 and therefore *must* share a common technical feature with the claims of examiner's Group I.

In addition, the claims of Groups I and II are essentially identical. The difference between Groups I and II is that the flexible absorbent sheet of Group I is incorporated into an absorbent article (a diaper). In other words, the claims of Groups I and II are each directed to the flexible absorbent sheet, as recited in claim 1. It is clear therefore that Groups I and II have a common technical feature.

The Office Action fails to indicate whether Groups I and II are classified in different classes or subclasses, but, even if differently classified, the inventions are not independent for the reasons set forth above *and* because the flexible sheet set forth in claims 1-17, and the article (diaper) set forth in claims 18-27, are so closely related that a search for applicants' flexible sheet claims would necessarily encompass a search for applicants' article (diaper) claims. In addition, a search for the claims of Group I would necessarily include a search to the claim of Group II, because the two Groups have identical flexible absorbent sheets.

Therefore, even if unity of invention arguably is lacking, no evidence exists that a search and examination directed to all claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

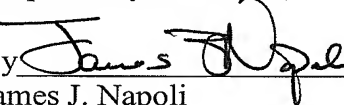
Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both applicants and the Patent Office to prosecute the flexible sheet and article (diaper) claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the flexible sheet and article claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the

Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action of the merits on all claims is solicited.

Dated: July 23, 2007

Respectfully submitted,

By 
James J. Napoli

Registration No.: 32,361
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant